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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,386	12/01/2000	Tadakatsu Shimada	PM 275953 SH-0022US	3958
909	7590	05/06/2004	EXAMINER	
PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102			HOFFMANN, JOHN M	
			ART UNIT	PAPER NUMBER

1731

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/727,386

Applicant(s)

SHIMADA ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 23, 50 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 23 and 50-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/27/04 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 17, 23 and 50-51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 17 requires that the swing suppression mechanism regulates a movement of the unit of the bar material. First it is noted that such is not defined or explained in the specification. Moreover, as indicated in the arguments of 4/02/04, Applicant believes that Tsuchiya does not meet this limitation. Tsuchiya is very similar to Applicant's invention – to the point that Examiner cannot tell any difference in the operations thereof. Examiner does not understand how Applicant's invention meets the language and Tsuchiya does not. Furthermore, one of ordinary skill would be at a

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complete loss as to how to avoid infringement – because it is unclear what is covered by “regulating a movement”.

Claim Rejections - 35 USC § 102

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Tsuchiya 5624474.

Looking to figure 4 and elsewhere: 50 is the support member which is one unit. 38 and/or 44 is the bar material that is held by the support member. As to the depositing of material: see col. 3, lines 12-13 and col. 1, lines 14-40. As to the rotating of the bar material, see col. 4, lines 44-60. and col. 7, Line 1. The radial movement is regulated to near zero- see abstract line 14. 56, 54 and 57 comprise the swing suppressing mechanism: it contacts the bar material 50 in a perpendicular direction in as much as Applicant's invention does.

Claim Rejections - 35 USC § 103

Claim 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya.

Tsuchiya does not disclose any sintering of the preform. It would have been obvious to sinter the soot body into glass and then draw it into a fiber, because that is its intended use. It would have been further obvious to perform the Tsuchiya process at multiple locations simultaneously, so that one can make multiple preforms. It would have been further obvious to have the multiple processes occurring in the same general area/building so that one expert could monitor all of them effectively. While one

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preform is being sintered in a first machine, it would be near a "sintering area" of a second machine. There would be sintering in each machine. It would have been obvious to keep it in that location for the entire sintering process - because any unnecessary movement of the apparatus might induce detrimental movements or temperature shocks to the operation. And making the apparatus move, would just require extra cost and/or effort to make it movable, to move it, and provide space to move it to. The maintaining step is deemed to only require that the preform stay in the same location from the instant it arrives at the sintering furnace - until it is heated up to a temperature which will sinter it. It is noted that the claim does not specify what is sintered.

Claims 50-51: it is deemed that Tsuchiya meets the claims in as much as the present invention does. As can be seen from figures 3-4, the inner surfaces of 56 and 54 are concave, The bearings are spherical rollers.

Response to Arguments

Applicant's arguments filed 4/02/04 have been fully considered but they are not persuasive.

It is argued that Tsuchiya rod can be moved freely. First, it is noted that Tsuchiya does not indicate this. Second, there is an allegation as to what is meant by "to suspend" – however there is no evidence to support this allegation. Third, just because something is free on its side, it doesn't mean that it can move to that side.

Fourth, the claim does not require no movement; on the contrary the second to last line of claim 17, refers that there is movement. Fifth, as indicated above, Applicant's specification does not indicate what is meant by regulating a movement: so it is impossible to conclude that Applicant is correct in arguing that Tsuchiya does not read on the claims.

It appears from Applicant's arguments that Applicant interprets the Tsuchiya invention is such that a slight nudge will cause the preform/rod to move – however with Applicant's invention, a more hefty nudge is required to make it move. Examiner would not agree with such, but even if such is the case, it is simply a matter of degree as to what amount of force (i.e. nudging) is required for movement. But neither the claims or specification indicate what force should be necessary. And such would appear to an obvious matter of design choice.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

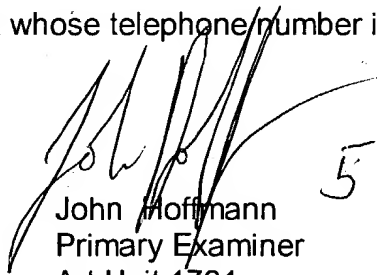
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.


John Hoffmann
Primary Examiner
Art Unit 1731

5-17-04

JMH